

Docket No. YAMAP0575US

Serial No.: 09/089,901

**REMARKS**

Claims 1-20 are pending in the application. Claims 1 and 11 are amended herein. Favorable reconsideration of the application, as amended, is respectfully requested.

Claims 1 and 11 have been amended in order to clarify further the distinctions between the present invention and that which is described in the art of record. The amendments are not intended to change substantially the scope of the original claims, but rather are provided in an effort to make more clear the distinctions as originally intended and inherent in the disclosed and originally claimed invention.

**Examiner Telephonic Interview Summary**

On April 13, 2005, Applicants' attorney and Examiner Psitos conducted a telephone interview, for which Applicants and Applicants' attorney thank the Examiner. In the interview, the rejections of Applicants' claims, particularly those under Section 112, were discussed. Applicants' attorney and the Examiner discussed various amendments that would address the Section 112 rejections, and which would also address the prior art rejections. Applicants' attorney submitted by facsimile on April 18, 2005, proposed amendments of claims 1 and 11. On about April 22, 2005, Applicants' attorney and Examiner Psitos conducted a further telephone interview to discuss the proposed amended claims. The Examiner indicated that the proposed amended claims appeared to address the Section 112 rejections, that he would enter the amended claims even though after final, and that he would consider the amended claims and Applicants' arguments with respect to the prior art.

The amended claims now submitted are in accordance with the discussions, although they differ somewhat from the claims submitted by facsimile on April 18, 2005.

The foregoing constitutes Applicants' summary of the substance of the telephonic interviews conducted with the Examiner on or about April 13 and 22, 2005, in accordance with 37 C.F.R. § 1.133 and MPEP § 713.04.

Docket No. YAMAP0575US

Serial No.: 09/089,901

**REJECTIONS OVER MIYASHITA ET AL.**

Claims 1-7, 9-17, 19 and 20 stand rejected as anticipated by Miyashita et al., U.S. Patent No. 5,949,747. Applicants respectfully traverse the rejection of these claims over this reference.

Miyashita et al. discloses a test recording method of determining an optimum power of the light output from a light source for erasing data recorded on a land and a groove of a recording medium. Miyashita et al. does not disclose the claimed sequence of recording a signal in both at least one continuous groove track and at least one continuous land track and, after recording the signal in both the groove track and the land track, then reproducing the signal from both the groove track and the land track, as claimed. Rather, it appears that Miyashita et al. discloses, e.g., in Fig. 10, determining optimum recording power (i.e., a control parameter) by simply recording on sector (M+2k) in track (N=1) with a selected recording power Pw, then recording on sector (M+2k) in track (N-1) with the recording power Pw, and then reproducing on sector (M+2k) in track (N) to obtain reproduction level, and using this to determine optimum recording power. The embodiments shown in Figs. 11 and 12 appear to include similar sequences. Thus, it appears that Miyashita et al., while carrying out a process of recording and reproduction to determine a control parameter, does *not* carry out the same sequence as that claimed, i.e., the sequence of recording a signal in both at least one continuous groove track and at least one continuous land track, and after recording the signal in both the groove track and the land track, then reproducing the signal from both the groove track and the land track, wherein, as the controller is changing the control parameter, during the steps of repeating the recording and reproduction and repeating the detection, the recording and reproduction unit is able to reduce a waiting time of disk revolutions to determine the control parameter, relative to a unit which records and reproduces a signal from a groove track and then records and reproduces a signal from a land track when the controller changes the control parameter. Miyashita et al. appear to perform this function as in the prior art, not as in Applicants' claims.

Docket No. YAMAP0575US

Serial No.: 09/089,901

With respect to this portion of the claims, the Examiner referred to col. 2, lines 1-24 of Miyashita et al. Miyashita et al. discloses at col. 2 from line 2 to line 12:

a test recording method of determining an optimum power of the light output from a light source in erasing pieces of information recorded on a land and a groove of a recording medium, comprising the steps of recording a predetermined signal of a predetermined track of the medium, erasing data on a track adjacent to the track, on which the signal is recorded, with different erasing powers, reproducing the signal recorded on the track and detecting a reproduction signal, and setting an optimum erasing power of the basis of the reproduction signal and the different erasing powers.

This does not disclose or suggest the claimed feature mentioned above. The remaining portion of the cited portion of col. 2, from line 13-24, discloses only means for carrying out the steps outlined in the preceding lines 2-12, not any additional steps.

Based on the foregoing, Applicants respectfully submit that Miyashita et al. fails to disclose the above-noted feature of Applicants' claimed invention. That is, while carrying out a process of recording and reproduction to determine a control parameter, Miyashita et al. does not carry out the same sequence as that claimed, i.e., the sequence of recording a signal in both at least one continuous groove track and at least one continuous land track, and after recording the signal in both the groove track and the land track, then reproducing the signal from both the groove track and the land track, wherein, as the controller is changing the control parameter, during the steps of repeating the recording and reproduction and repeating the detection, the recording and reproduction unit is able to reduce a waiting time of disk revolutions to determine the control parameter, relative to a unit (such as that of Miyashita et al.) which records and reproduces a signal from a groove track and then records and reproduces a signal from a land track when the controller changes the control parameter.

As such, Applicants respectfully submit that Miyashita et al. does not and cannot anticipate the claimed invention.

Docket No. YAMAP0575US

Serial No.: 09/089,901

***REJECTIONS OVER JP 04-141827 IN VIEW OF MORIYA ET AL., SENSU OR ITOI AND FURTHER IN VIEW OF MIYASHITA ET AL.***

Claims 1, 2, 7, 9, 11, 12, 17 and 19 stand rejected as obvious over the allegedly acknowledged prior art JP 4-141827 (JP '827) further considered with Moriya et al., U.S. Patent No. 5,508,995, and all further considered with either Senshu, U.S. Patent No. 6,058,099 or Itoi, U.S. Patent No. 5,995,458, and all further considered with Miyashita et al., U.S. Patent No. 5,949,747.

The Examiner contended that JP '827, "discloses a basic parameter testing-calibrating capability wherein the parameter selected is one of power, which is equivalent to intensity." The Examiner admitted that JP '827 lacks any mention of a spiral track environment or that information can be recorded on/in all areas. The Examiner contends that Moriya et al. shows that the spiral track environment and that information can be recorded on/in all areas is well known.

Regarding the "wherein" clause, the Examiner first stated his interpretation that the claims mean that the recording of the information is continuously performed from the land to the groove (or alternatively from the groove to the land). The Examiner contends that either of Senshu or Itoi teach such recording technique.

Applicants traverse the Examiner's interpretation of both the cited references and Applicants' claimed invention. In order to more clearly describe the claimed invention and to further clarify the distinctions between the present invention and that which is described in the art of record, Applicants have further amended herein the "wherein" clause and other related recitations of the claims to make clear that it is during the time when ("as") the controller is changing the control parameter, during the steps of repeating the recording and reproduction and repeating the detection, that the recording and reproduction unit is able to reduce a waiting time of disk revolutions to determine the control parameter relative to a unit which records and reproduces a signal from a groove track and then records and reproduces a signal from a land track when the controller changes the control parameter. In addition, Applicants amended

Docket No. YAMAP0575US

Serial No.: 09/089,901

the "controller" clause to eliminate redundant language and to clarify that, in addition to the repeating the recording and reproduction performed by the recording and reproduction unit, the detection performed by the detector is also repeated every time the control parameter is changed.

Applicants respectfully submit that the contended combination of prior art references fails to disclose or suggest any such features. As explained in the following, the pending claims make clear the distinction over the prior art.

Senshu discloses an optical disc having a land and a groove, in which information is recorded and/or reproduced on or from a track on the land and the groove. The optical disc has an address section having a group of address information data previously formed at a pre-set period on the track. The group of address information is arranged with an offset in the track direction in an ordered pattern. The address section may be arranged at switching positions from the land to the groove or vice versa. Applicants submit that Senshu, taken together with JP '827 and Moriya et al., neither discloses nor suggests the features of the presently claimed invention.

The Examiner cited Senshu at col. 4, lines 56-59 in support of the rejection. However, the cited disclosure merely states that the interchanging of the grooves and the lands need not be done *once* each track turn, but may also be done *an odd number of times* per track turn. This disclosure, taken together with JP '827 and Moriya et al., does not support the Examiner's position. This does not disclose or suggest any relationship between this feature of Senshu and the determination and changing of a control parameter in these disclosures.

Itoi discloses a method of scanning an optical disk having a land area and a groove area in a double spiral configuration. Itoi scans one of the two areas continuously radially inward or radially outward, and scans the other area inward or outward from the end of the scanning of the one area. The groove area, if the land area is scanned first, or the land area, if the groove area is scanned first, is scanned outward or inward from the end of the scanning of the previous area. That is, one of

Docket No. YAMAP0575US

Serial No.: 09/089,901

the land area and groove area is continuously scanned without any jump. Thus, in Itoi, the land groove is scanned from end to end, and then the groove track is scanned from end to end. Applicants submit that Itoi, taken together with JP '827 and Moriya et al., neither discloses nor suggests the features of the presently claimed invention.

The Examiner cited Itoi at col. 1, line 51 to col. 2, line 5 in support of his rejection. However, the cited disclosure merely states that an MCAV recording system, which maintains the rotation speed of a disk constant and increases the amount of data per track in proportion to the radius of the disk, can be combined with a land/groove recording system. As a result, a moving picture may be continuously recorded in both the land portion and groove portion of a disk. This disclosure, taken together with JP '827 and Moriya et al., does not support the Examiner's position. This does not disclose or suggest any relationship between this feature of Itoi and the determination and changing of a control parameter in these disclosures.

The addition of Miyashita et al. does not cure the deficiencies of the other references, and the combination of all these references fails to render obvious Applicants' claimed invention.

Withdrawal of the rejection is respectfully requested for at least the foregoing reasons.

Because every invention is, essentially, a combination of pre-existing elements, *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458, (Fed. Cir. 1988), obviousness cannot be established simply by finding bits and pieces of the claims and using the hindsight provided by the present invention to contend that a person of ordinary skill would have considered it obvious to cobble together selected elements of the cited references. Rather, there must be a *specific* teaching or suggestion for combining the elements *as they appear* in the present claims. See, *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). (Emphasis added.) Applicants respectfully submit that, while the prior art contains similar disclosures to that presently claimed, the prior art fails to disclose or suggest the presently disclosed and

Docket No. YAMAP0575US

Serial No.: 09/089,901

claimed invention when considered *as a whole*. As stated in *Dembiczak*, the showing of a suggestion, whether in the prior art itself or in the nature of the problem to be solved, must be clear and particular and specific. There must be a motivation to make the specific combination of elements as claimed, in order to state a *prima facie* case of obviousness. Applicants respectfully submit that no such showing has been made in the present case.

### CONCLUSION

Accordingly, all of claims 1-20 are believed to be allowable and the application is believed to be in condition for allowance. Action to such end is earnestly solicited.

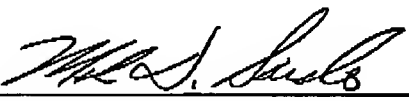
Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

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Date: May 31, 2005

  
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